

REMARKS/ARGUMENTS

This amendment is in response to the final Office Action dated September 1, 2005 and the Advisory Action dated February 2, 2006. An amendment after final was submitted on January 6, 2006 but was not entered per the Advisory Action. Claims 1, 4 and 9 have been amended in the current submission. No new matter has been added by these amendments. Support for the amendments may be found, by way of example only, on pages 9-10 of the instant application. Therefore, claims 1-20 are again presented for the Examiner's consideration in view of the following remarks. A petition for a three-month extension of time is respectfully submitted herewith along with a Request for Continued Examination.

Reexamination and reconsideration of the above-identified application, pursuant to and consistent with 37 C.F.R. § 1.116, and in light of the amendments and remarks that follow, are respectfully requested. Because the present claims are believed to be in condition for allowance over the cited art, good cause exists for the entry of this amendment in accordance with 37 C.F.R. § 1.116.

As an initial matter, applicant would like to thank the Examiner for acknowledging the claim to foreign priority under 35 U.S.C. § 119 in the Office Action.

Claim 4 was objected to because of an informality which has been remedied by changing the word "an" immediately before "DNS" to "a". Therefore, applicant respectfully requests that the objection to claim 4 be withdrawn.

Claims 1-3, 5, 7-12 and 14-20 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,694,133 ("Tobita") in view of U.S. Patent No. 6,370,394 ("Anttila"). Applicant respectfully traverses the rejection.

Applicants respectfully submit that *Tobita* and *Anttila*, taken alone or in combination, neither disclose nor suggest the inventions of independent claims 1, 9 and 14-20. Indeed, as will be demonstrated below, the Examiner's rejection should be withdrawn for at least two reasons: (1) the combination does not result in the claimed invention; and (2) there is no motivation to combine the references to arrive at the invention.

As to the first requirement, the technical teachings of *Tobita* and *Anttila* are such that their combination would not result in the claimed invention.

The Examiner admits that *Tobita* does not teach a relay apparatus that is operable to convert a telephone number of a multi-function mobile telephone into an ID code unique to the multi-function mobile telephone. (See Office Action, pg. 3, numbered section 5.a.) As *Tobita* does not teach such a conversion, it is also not possible for *Tobita* to perform communication between the multi-function mobile telephone and the content providing apparatus through the relay apparatus based on the unique ID code.

In order to overcome *Tobita*'s deficiency, the Examiner relies on *Anttila*. According to the Office Action, "*Anttila* teaches wherein the telephone number is converted into an ID code." (Office Action, pg. 3, numbered section 5.a.)

The invention of *Anttila* "relates to a system and a method for establishing a telecommunication connection and transferring calls in a telecommunication network and a data transfer network. The invention further relates to a mobile station comprising connecting means for establishing a telecommunication connection and transferring information between the mobile station and said telecommunication network and data transfer network." (Col. 1, ll. 6-13.) Call routing

is facilitated by a database arranged in connection with the network server, in which database it is stored the identification information (e.g. a IP-address) defined for the telephone number of each mobile station according to the invention. The network server also answers for the protocol conversions, prior known to a person skilled in the art, from a circuit switched telephone network to e.g. a packet-switched interconnecting network and vice versa. When a mobile station according to the invention is connected to a terminal device, an application program executed in the terminal device polls the identification (IP--address) of the "own" terminal device of mobile station stored in the mobile station and compares it with its own one. If the IP--addresses match, the terminal device knows that the connected terminal device is an "own" terminal device. In this case both incoming and established calls are transferred based upon the information contained in a database.

(Col. 4, ll. 28-44, emphasis added.)

Subsequently, Anttila states with regard to the flow diagram of FIG. 5 that "The identification is performed comparing IP-address 37 stored in the memory of mobile station 10 with IP-address 47 of terminal device 40. If own mobile station 10 is concerned (IP-addresses 37 and 47 match), the connection is accepted and the execution of the program goes to step 159, in which the activity of the telecommunication connection is checked. (Col. 11, ll. 5-11.) Anttila goes on to state "Routing message 64 is transmitted preferably based upon IP-address 37 stored in the memory of the mobile station, but it would be equally possible to use another type of identification, such as the telephone number of mobile station 11, 12, 13." (Col. 11, ll. 27-31.) The identification information of Anttila may be "defined" for a telephone number; nonetheless, the Examiner does not assert, and Antilla is devoid of any teaching or suggestion, that the identification information such as the IP address is "an ID code unique to the multi-function mobile

telephone" or "a unique code" that is obtained by converting a telephone number of the multi-function mobile telephone or terminal as required by independent claims 1, 9 or 14-20. Thus, Anttila cannot remedy the deficiencies of Tobita.

The Advisory Action states Anttila "teaches wherein routing is facilitated with by a database that stored the identification information defined for the telephone number of each mobile station." (Advisory Action, page 2.) However, such a statement does not address the aforementioned conversion of the telephone number into a unique ID code.

Even if one could import the teachings of Anttila into Tobita, which applicant does not believe is the case, the combination would not have each and every element required by independent claims 1, 9 and 14-20. As explained in the reply to the previous Office Action, according to Tobita, "gateway server 2 is constructed so as to, when a request comes in from the mobile phones 4, convert the intrinsic identifier which is provided to the request of the mobile phones 4 into a user ID corresponding to this intrinsic identifier by using the user ID list table 70, and to transfer the request to the IP server 1." (Col. 9, line 66 to col. 10, line 4, emphasis added.) The "intrinsic identifier" of Tobita is clearly and simply not the same as the telephone number required by the independent claims of the instant application. In accordance with Antilla, an IP address or other identification information would be stored in a database. Importing the teachings of Anttila into Tobita would apparently result in the "intrinsic identifier" or corresponding "user ID" being replaced by identification information such as the IP address. However, this would appear to vitiate a key feature of Tobita, namely that "[t]he user ID is an identifier for specifying a user" who is a member of an image delivery service. (Col. 9, ll. 13-16.) Applicant respectfully submits

that converting the telephone number of the multi-function mobile telephone or terminal cannot result in the IP address of Anttila. Also, there is no teaching or suggestion as to how Tobita could be redesigned to incorporate the elements of Anttila. Finally, it is not even clear that such a combination is feasible based upon the configuration and purpose of Tobita's image providing system.

As to the second requirement, for the Examiner to meet his burden under 35 U.S.C. § 103(a) to reject, for example, the independent claims, he must establish that one skilled in the art would be motivated to combine the teachings of Tobita and Anttila. Neither reference provides such motivation. As stated above, one would have to fundamentally alter the system and functionality of Tobita to incorporate Anttila's different components. The fact that a prior art process or device could be modified so as to produce the claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). As stated in *In re Oetiker*, 997 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992):

There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself.

There is simply no teaching or motivation in the cited art to reengineer the Tobita system using the IP address of Anttila in order to arrive at the inventions of independent claims 1, 9 and 14-20. The Office Action cites to Anttila at column 3, lines 34-41 to supply a motivation, stating "It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the telephone

number is converted into an ID code as taught by Anttila in the claimed invention of Tobita et al in order to provide an arrangement in which the same devices can be used as terminal devices in the telecommunication system equally well while connected to telecommunication networks realized using line connections." (Office Action, pg. 3, numbered section 5.a.) It is unclear how "line connections" have any bearing on either the claimed invention of the instant application or upon Tobita, and thus it does not appear that there is any motivation to combine the references in the manner suggested in an attempt to meet all of the limitations of the claimed invention.

In addressing the lack of motivation to combine Anttila and Tobita, the Advisory Action merely states "it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter or obvious design choice [sic]. *In re Leshin*." (Advisory Action, page. 2.)

Applicant respectfully submits that *In re Leshin* has been misapplied. The *Leshin* case is cited in the MPEP to support the proposition that "the selection of a known material based on its suitability for its intended use support[s] a *prima facie* obviousness determination." (MPEP § 2144.07.) As stated in the MPEP, "See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious)." (*Id.*) When relying on Anttila to overcome the admitted deficiencies of Tobita, the Office Action is not selecting a "known material" to replace another in a "design choice." Instead, the Office Action seeks to reengineer Tobita using a purported teaching of Anttila.

In a case significantly more factually similar to *In re Leshin* than the combination in the pending Office Action, the

Board of Patent Appeals and Interferences rejected an obviousness combination asserted in view of *In re Leshin*. See *Ex parte Tsai*, Appeal No. 2001-1849 (non-precedential). In that case, the examiner relied on *In re Leshin* to substitute a polymer from one reference for a polyester in another reference. (*Id.* at pgs. 4-5.) While not written for publication and not binding precedent of the Board of Patent Appeals and Interferences, *Ex parte Tsai* explains that mere assertion of similarity of materials is insufficient to support a *prima facie* case of obviousness. (*Id.* at pg. 5.) Among other requirements, the applied references need to provide a reasonable expectation of success. (*Id.*) This has not been done in the pending Office Action or in the Advisory Action.

Therefore, for at least these reasons, applicant respectfully requests that the rejection of independent claims 1, 9, and 14-20 be withdrawn. In addition, claims 2-3, 5 and 7-12 depend from independent claims 1 and 9, respectively, and include all the limitations thereof as well as other limitations neither disclosed nor suggested by the references of record. Thus, applicant submits that the subject dependent claims are also in condition for allowance.

Notwithstanding the aforementioned deficiencies of *Tobita* and *Anttila* and the lack of motivation to combine and modify the references, independent claims 1 and 9 have been amended to further clarify their inventions.

Claim 1 now recites "a content providing apparatus for providing content, the content providing apparatus including a memory...wherein the memory of the content providing apparatus is for storing a variety of statuses of the multi-function mobile telephone by the unique ID code and for storing progress of current game playing, so that if a game is suspended during

operation, the game may be resumed at a point of suspension by re-accessing the memory of the content providing apparatus.."

Claim 9 now recites " the server comprises: a unit for providing the content to the terminal a memory; and a unit for identifying the terminal to which the content is provided based on the unique code; wherein the server memory is for storing a variety of statuses of the multi-function mobile telephone by the unique code and for storing progress of current game playing, so that if a game is suspended during operation, the game may be resumed at a point of suspension by re-accessing the server memory."

Neither *Tobita* nor *Anttila*, either alone or in combination, teaches, discloses or otherwise suggests all of the elements of independent claims 1 and 9. By way of example only, neither reference teaches or suggests a server memory or a content providing apparatus memory for storing status information of the mobile telephone with a unique (ID) code as well as storing gaming progress as required by the claims.

The other art of record does not remedy the deficiencies of *Tobita* and *Anttila*. Thus, claims 1 and 9, as well as dependent claims 2-3, 5 and 7-8, should also be allowed for these reasons as well.

Dependent claim 4 was rejected under 35 U.S.C. § 103(a) as being obvious over *Tobita* and *Anttila* in view of U.S. Published Application No. 2005/0021863 ("*Jungck*"). Dependent claim 6 was rejected under 35 U.S.C. § 103(a) as being obvious over *Tobita* and *Anttila* in view of U.S. Patent No. 6,148,253 ("*Taguchi*"). Dependent claim 13 was rejected under 35 U.S.C. § 103(a) as being obvious over *Tobita* and *Anttila* in view of U.S. Published Application No. 2001/0025275 ("*Tanaka*"). Claims 4, 6 and 13 depend from independent claims 1 and 9, respectively, and include all the limitations thereof as well as other limitations

neither disclosed nor suggested by the references of record. Neither *Jungck*, *Taguchi* or *Tanaka* overcome the fundamental deficiencies of *Tobita* and *Anttila* noted above. Thus, applicant submits that dependent claims 4, 6 and 13 are also in condition for allowance.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have. If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: February 28, 2006

Respectfully submitted,

By 

Andrew T. Zidel

Registration No.: 45,256
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicant